

Application No.: 10/014,179
Attorney's Docket No.: US 010588

REMARKS/ARGUMENTS

Applicant acknowledges receipt of the Office Action dated July 31, 2006. Claims 1-8, 10-34 and 36-38 are pending in this application of which 1, 11, and 34 are independent. By this Amendment, claims 11 and 34 are amended. Claims 9 and 35 have previously been cancelled.

Rejections under 35 U.S.C. § 103

In section 1, on pages 2-6 of the Office Action, claims 1-8, 10-30, 34 and 36 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,676,138 to Zawilinski, in view of U.S. Patent No. 6,400,996 to Hoffberg et al. (hereinafter "Hoffberg"). Applicants respectfully traverse this rejection.

Claim 1 recites, "the at least one sensor includes a microphone for picking up vocalizations made by the viewer" and "a processor for receiving the sensor signal and analyzing it to determine if it can be associated with at least one recognizable viewer emotional response." Claims 11 and 34 contain similar recitations.

Near the bottom of page 2, the Office Action correctly concedes that Zawilinski fails to disclose, teach or suggest a microphone picking up vocalizations made by a user. In order to overcome this correctly conceded deficiency in Zawilinski, the Office Action relies on Hoffberg and asserts that the subject matter is inherent in Hoffberg.

At the top of page 3, the Office Action puts forth an alleged motivation to combine the respective teachings of Zawilinski and Hoffberg. Specifically, the Office alleges that the necessary

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combination would be desirable, "to provide additional physiological data from which the user's preferences can be inferred." However, the asserted objective is not found in either Zawilinski or Hoffberg.

Thus, the Office Action does not cite any portion of either Zawilinski or Hoffberg in support of the alleged motivation to combine their respective teachings, to the exclusion of other teachings. Applicant respectfully requests that, should the rejection be maintained in response to this Amendment, the rejection be supplemented with a citation to Figure, Abstract, and/or column and line number in Zawilinski and/or Hoffberg where the alleged motivation can be found to combine the respective teachings of Zawilinski and Hoffberg, to the exclusion of the other teachings in the references, as necessary to arrive at the subject matter recited in the rejected claims.

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

"The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). Here, it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, as

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mentioned above, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the subject matter according to the combinations recited in the rejected claims. The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Since the alleged objective or motivation of providing additional physiological data from which the user's preferences can be inferred, is not found anywhere in the cited references, it is logically deduced that the Office is either relying on the applicant's specification as a blueprint for piecing together a prior art rejection based on improper hindsight, or the Office is relying on personal knowledge, which is equally improper. If the Examiner is improperly relying on his own "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry (i.e., the Examiner attempts to substitute facts within his personal knowledge for a reference showing the asserted motivation to combine the references), Applicant respectfully requests an affidavit under 37 C.F.R. § 1.104(d)(2) from the Examiner. According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon within the Examiner's own knowledge, subject to contradiction or explanation by the Applicant and other persons.

Applicant reiterates that if the rejection is not supplemented to provide a citation to Figure, Abstract, and/or column and line number in Zawilinski and/or Hoffberg where the alleged motivation can be found to combine the respective teachings of Zawilinski and Hoffberg, to the

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in the rejected claims, then it is presumed that the Examiner is relying on his own personal knowledge and the Examiner is required to submit an affidavit under 37 C.F.R. § 1.104(d)(2) in accordance with Applicant's request herein.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

For at least the foregoing reasons, it is respectfully requested that the rejection in section 1 of the Office Action be withdrawn.

In section 2, on page 6 of the Office Action, claims 31 and 32 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Zawilinski in view of Hoffberg as applied to claim 27 above, and further in view of U.S. Patent No. 5,774,591 to Black et al. (hereinafter "Black"). In section 3 on page 7 of the Office Action, claims 33 and 38 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Zawilinski in view of Hoffberg as applied to claims 11 and 34 above, and further in view of U.S. Patent Publication No. 2003/0101449 to Bentolila et al. (hereinafter "Bentolila"). In section 4 on pages 7 and 8 of the Office Action, claim 37 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Zawilinski in view of Hoffberg as applied to claim 34 above, and further in view of U.S. Patent Publication No. 2003/0005431 to Shinohara. Applicants respectfully traverse these rejections.

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Claims 31-34, 37 and 38 are allowable based at least on their dependency from claims 1, 11 and 34, respectively, for the reasons stated above in connection with the rejection of claims 1, 11 and 34. Further, claims 31-34, 37 and 38 are allowable based at least on the separately patentable subject matter recited therein.

Still further, as described above, it is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. The factual inquiry whether to combine references must be thorough and searching. As with the earlier rejection, here again it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the subject matter according to the combinations recited in the rejected claims. The factual question of motivation to combine references is material to patentability, and [can] not be resolved on subjective belief and unknown authority.

Applicants respectfully assert that only by the impermissible use of hindsight knowledge of Applicants' own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

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For at least the foregoing reasons, it is respectfully requested that the rejections of claims 31-34, 37 and 38 in sections 2-4 of the Office Action be withdrawn.

CONCLUSION

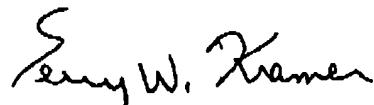
In view of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the correspondence attorney listed below in order to expeditiously resolve any outstanding issues.

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In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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